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FREDERICK W. GIBB, III Gibb Intellectual Property Law Firm, LLC 2568-A RIVA ROAD SUITE 304 ANNAPOLIS, MD 21401				
EXAMINER				
VEZERIS, JAMES A				
ART UNIT		PAPER NUMBER		
3693				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,798

Applicant(s)

ANANTHANARAYANAN ET AL.

Examiner

JAMES A. VEZERIS

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12-14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-14 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Final Action

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Pre-Exam Formalities

2. Claims 1-4, 6-10, 12-14, and 17 are currently pending in the application.
3. Claims 1, 6, and 14 are amended.
4. The objections to claim 14, regarding minor informalities is withdrawn.

Response to Applicant's Arguments

5. The 35 U.S.C. 101 rejections of claims 1-4 and 6 still stand. Placing a system into the pre-amble of a method claim is not enough to overcome the 101 rejection. Actual physical structure must be included in the body of the claims. Examiner further

notes that a computer-implemented method could also be defining computer code per-se which is not statutory subject matter.

6. Applicant's arguments filed 12/10/2008 have been fully considered but they are not persuasive. Examiner believes the underlined sections of the applicant's response point to the areas of contention the applicant has in regard to the 102(e) rejection.

7. In regards to claims 1-4, 6, 7, 9, 10, 12-14, and 17 applicant argues Priest does not teach, "executing a multi-party trading mechanism"; "invoking a standalone bilateral negotiations"; "evaluating the attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone bilateral negotiations." examiner disagrees. Priest teaches, "executing a multi-party trading mechanism" in paragraph 56, where multiple participants engage in trading. Priest teaches "invoking a standalone bilateral negotiations" in paragraph 62, where a negotiation host takes two or more negotiating parties are close to an agreement and helps them reach a final agreement. Priest also teaches "evaluating the attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone bilateral negotiations." In paragraphs 55-63 where applicant's parties agree in multi-lateral negotiation and when an agreement is close switch to stand-alone negotiations.

8. Examiner reminds applicant that the broadest reasonable interpretation of claim language is being used. Examiner encourages applicant to further define key terms to overcome prior art rejections.

9. In response to applicant's arguments regarding claim 8, examiner disagrees and maintains that past trade history is shown in Holden.

Claim Objection

10. Applicant claims "means for" language in claim 7 without providing an algorithm to perform the specific functions. Applicant should either amend the claims to clarify the means for language, or provide the examiner with the relevant support of the claim language in the specification.

Claim Rejections- 35 U.S.C. 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 and 6 of the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. While claims 1-4 and 6 recite an online market, the online market is being defined as code per-se and therefore does not overcome the non-statutory rejection.

Claim Rejections- 35 U.S.C. 102(e)

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 7, 9, 10, 12-14, and 17 rejected under 35 U.S.C. 102(e) as being anticipated by US PG-Pub 2002/0120588 A1 to Preist et al. (Hereinafter "Preist")

Regarding Claims 1, 6, 7, 12, and 17.

Preist teaches a computer-implemented method of trading in an online market, the online market comprising a user and a plurality of trading parties, the method comprising:

specifying, by a user, initial requirements for initiating trading among trading parties in said online market;

executing a multi-party trading mechanism to arrive at trading offers, the trading offers being submitted by the trading parties based on the initial requirements of the user;

wherein the multi-party trading mechanism comprises one of a continuous double auction, a call market, an ascending price auction, a descending price auction, a first price sealed bid auction, a uniform second price auction, and a reverse auction conducted by the user and the trading parties;

selecting a first trading offer from the trading offers of said multi-party trading mechanism;

invoking standalone bilateral negotiations, which stand apart from the multi-party trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offers, said invoking further comprising:

agreeing upon a protocol for conducting the standalone negotiations;

exchanging offers as per the agreed upon protocol; and

concluding the standalone negotiations as per the agreed upon protocol;

repeating said executing of said multi-party trading mechanism, and either said selecting of said trading offers of said multi-party trading mechanism or said invoking said standalone bilateral negotiations to obtain either attractive and feasible trading offers from the multi-party trading mechanism or said customized trading offers from the standalone bilateral negotiations, respectively;

evaluating the attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone bilateral negotiations by any of a utility function based on multiple attributes of a traded good or a traded service, a user-specified weights associated with the traded good or the traded service, and a user-specified costs associated with the multiple attributes of the traded good or the traded service; and

concluding trading deals based on evaluated attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone

bilateral negotiations, whereby said multi-party trading mechanism and said standalone bilateral negotiations are combined.

(See Preist Paragraphs 55-63)

Regarding Claims 2, 9, and 13.

Preist further teaches the invoking the standalone bilateral negotiations comprises:

agreeing upon a protocol for conducting the standalone negotiations;
exchanging offers as per the agreed upon protocol; and
concluding the standalone negotiations as per the agreed upon protocol. (See

Preist Paragraphs 55-63)

Regarding Claims 3, 10, and 14.

Preist further teaches the exchanging offers comprises:
receiving offers from the trading parties;
evaluating the received offers;
generating counter-offers on a basis of evaluated offers;
sending counter-offers to the trading parties; and
repeating said receiving, said evaluating, said generating and said sending in accordance with the agreed upon protocol. (See Preist Paragraphs 55-63)

Regarding Claim 4.

Preist further teaches the online market is a regulated online market, the online market being regulated to increase trading efficiency of the online market, the trading

efficiency of the online market being governed by a number of trading parties that strike a trading deal. (Paragraphs 6 an 7)

Claim Rejections- 35 U.S.C. 103(a)

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Preist in view of US PG-Pub 2001/0032175 A1 to Holden et al. (Hereinafter "Holden").

Regarding Claim 8.

Preist teaches executing a trading mechanism further comprises:

a repository containing information related to the initial requirements of trading parties; (See Preist Paragraphs 55-63)

Priest fails to teach a repository containing information related to past trading

deals; and

a repository containing information related to the trading parties.

Holden teaches:

a repository containing information related to past trading deals; (See Holden Claim 14)

a repository containing information related to the trading parties. (See Holden Paragraph 37)

It would be obvious to one skilled in the art to combine Holden and Preist.

There is motivation to do so because Preist relies on past trading deals and information relating to the parties which can be provided by Holden allowing Preist to make more accurate, and efficient negotiations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/
Examiner, Art Unit 3693

3/4/2009